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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,160	02/24/2004	Tsuneaki Kondoh	249206US3	8288
22850	7590	07/05/2006		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER ZACHARIA, RAMSEY E				
ART UNIT		PAPER NUMBER		
1773				

DATE MAILED: 07/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/784,160

Applicant(s)

KONDOH ET AL.

Examiner

Ramsey Zacharia

Art Unit

1773

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 26 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-9.  
Claim(s) withdrawn from consideration: 10-18.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
Ramsey Zacharia  
Primary Examiner  
Tech Center 1700

Continuation of 3. NOTE: The proposed limitation that the elastic layer consists mainly of silicone rubber and/or fluorosilicone rubber free from organosilicone compounds having at least one hydrogen bonded to a silicone atom in one molecule represents a new issue that was not raised during prosecution which would require further search and consideration. Moreover, this proposed limitation raises questions of indefiniteness since the meaning of the transitional phrase "consisting mainly of" is unclear. It is also not clear if it is just the fluorosilicone rubber that is free from organosilicone compounds having at least one hydrogen bonded to a silicon atom in one molecule or both the silicone rubber and the fluorosilicone rubber that are free from organosilicone compounds having at least one hydrogen bonded to a silicon atom in one molecule. Further reason for not entering the proposed amendment is that it would appear upon entry that claim 2 would no longer further limit claim 1. The proposed limitation also raises the issue of new matter since there does not appear to be any support in the disclosure as originally filed for the negative limitation that the fluorosilicone rubber (or silicon and/or fluorosilicon rubbers) are free from organosilicone compounds having at least one hydrogen bonded to a silicon atom in one molecule (see MPEP 2173.05(i)). Therefore, for at least these reasons the proposed amendment is not deemed to place the application in better form for appeal because it does not materially reduce or simplify the issues for appeal.

Continuation of 11. does NOT place the application in condition for allowance because: claim 1 does not recite a "thermal fixing roll" but rather a "fixing member" which, according to page 2, lines 7-9 of the instant specification, includes both a thermal fixing roller and a pressurizing roller. Moreover, the applicants' arguments that the "fixing member" preamble differentiates the claimed invention over the prior art is not persuasive because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the structural limitations are able to stand alone (see MPEP 2111.02). The argument that the thermal fixing roll of claim 1 (if claim 1 were to recite a thermal fixing roll as opposed to a fixing member as currently recited) and the pressing roll of Fukunaga differ from each other in terms of the required characteristics and physical properties is unpersuasive because claim 1 does not recite any of these differing characteristics and physical properties..